

Best Available Copy

REMARKS

After entering these amendments, Claims 1-2, 4-7 and 12 will be pending. Claims 1, 3 and 5 have been amended. Claim 3 has been canceled. Claims 8-11 and 13-21 have been withdrawn from consideration.

THE REJECTIONS UNDER 35 U.S.C. §102:

Claims 1-7 and 12 were rejected under 35 U.S.C. §102(a) (e) as being anticipated by US 6,365,615 (hereinafter “Kelly”). (June 6, 2006 Office Action, Page 4). Applicants respectfully traverse.

The Examiner states that Kelly et al. “clearly anticipate the instant compounds of formula (I)...” (June 6, 2006 Office Action, Pages 5-6). Applicants have amended Claim 1 and thereby Claims 2, 4-7 and 12 to delete “aryl and substituted aryl” from the definition of variables R⁶ and R⁶. Kelly’s variable R², which corresponds to applicants’ variable W being CR⁶R⁶, must be aryl.

Claims 1-7 and 12 were rejected under 35 U.S.C. §102(e) as being anticipated by US 6,670,386 (hereinafter “Sun”). (June 6, 2006 Office Action, Page 6). Applicants respectfully traverse.

The Examiner contends that Sun et al “clearly anticipate the instant compounds of formula (I)...” (June 6, 2006 Office Action, Page 7). Applicants respectfully disagree. Applicants specifically drafted the second proviso to Claim 1 (Page 229, line 28 to page 230, line 26 of the application as originally filed) to specifically delete the compounds disclosed in Sun from Claim 1.

Claims 1-7 and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by WO 00/72845 (hereinafter “Palovich”). (June 6, 2006 Office Action, Page 7). Applicants respectfully traverse.

The Examiner contends that Palovich et al. “clearly anticipate the instant compounds of formula (I)...” (June 6, 2006 Office Action, Page 8). Applicants respectfully disagree. Palovich does not anticipate the central bicyclic core of applicants compounds. The Examiner directs applicants’ attention to page 7, lines 11-12 and 15-16 of Palovich for specific examples; however these examples have a mono-cyclic imidazole ring as their central core and not the bi-cyclic core of applicants’ compounds.

Claims 1-7 and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by European Journal of Medicinal Chemistry (1996), 31(9), 717-723 (hereinafter “Issartel”). (June 6, 2006 Office Action, Page 8). Applicants respectfully traverse.

Best Available Copy

The Examiner states that Issartel et al. "clearly anticipate the instant compounds of formula (I)..." (June 6, 2006 Office Action, Page 9). Applicants have amended Claim 1 and thereby Claims 2, 4-7 and 12 to delete "OR₃" from the definition of variables R² and R^{2'}. Issartel teaches compounds wherein the carbon atom that is substituted with variables R² and R^{2'} in the instant application must be substituted with a hydroxyl group.

Claims 1-7 and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by WO 01/30781 (hereinafter "Sircar"). (June 6, 2006 Office Action, Page 9). Applicants respectfully traverse.

The Examiner states that Sircar et al. "clearly anticipate the instant compounds of formula (I)..." (June 6, 2006 Office Action, Page 10). Applicants have amended Claim 1 and thereby Claims 2, 4-7 and 12 to delete "arylalkyl and substituted arylalkyl" from the definition of variable R¹. Sircar teaches compounds wherein the substituent that corresponds to applicants' variable R¹ must be an aryl or heteroaryl group linked through an alkyl, perfluoroalkyl or carbonyl group. (Sircar page 3, line 10).

Therefore in light of the above arguments and amendments, applicants respectfully request the Examiner remove the rejections under 35 U.S.C. § 102 as they are now moot.

THE REJECTIONS UNDER 35 U.S.C. §103:

Claims 1-7 and 12 were rejected under 35 U.S.C. §103(a) as being anticipated by WO 01/30781 (hereinafter "Sircar"). (June 6, 2006 Office Action, Page 12). Applicants respectfully traverse.

The Examiner states that Sircar's variable K represents -CH₂- and the variable R represents optionally substituted aryl. (June 6, 2006 Office Action, Pages 12-13). Applicants have amended Claim 1 and thereby Claims 2, 4-7 and 12 to delete "arylalkyl and substituted arylalkyl" from the definition of variable R¹, which corresponds to Sircar's variables K and R. One of skill in the art would not be led by the teaching of Sircar, which requires an arylalkyl or substituted arylalkyl group that corresponds to applicants' variable R¹, to make the bicyclic compounds of the present application.

Claims 1-7 and 12 were rejected under 35 U.S.C. §103(a) as being anticipated by US 6,365,615 (hereinafter "Kelly"). (June 6, 2006 Office Action, Page 14). Applicants respectfully traverse.

Best Available Copy

The Examiner states that Kelly's variable R² "represents hydrogen, methyl, or Cl". (June 6, 2006 Office Action, Page 15). Applicants respectfully disagree. Kelly's variable R², which corresponds to applicants' variable W being CR⁶R⁶, must be aryl. Applicants have amended Claim 1 and thereby Claims 2, 4-7 and 12 to delete "aryl and substituted aryl" from the definition of variables R⁶ and R⁶. One of skill in the art would not have been led by the teaching of Kelly, which requires an aryl group or substituted aryl group that corresponds to applicants' variable W being CR⁶R⁶, to make the bicyclic compounds of the present application.

Therefore in light of the above arguments and amendments, applicants respectfully request the Examiner remove the rejections under 35 U.S.C. § 103 as they are now moot.

DOUBLE PATENTING:

Claims 1-7 and 12 were provisionally "rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of Sun et al. US 6,670,386." (June 6, 2006 Office Action, Page 17). Applicants respectfully traverse.

The genus of compounds disclosed by Sun have been unambiguously excised from the scope of Claim 1 and therefore claims 2, 4-7 and 12 by applicants' second proviso to Claim 1 (Page 229, line 28 to page 230, line 26 of the application as originally filed). One of skill in the art would not be motivated to make claimed compounds of the present application in view of the teaching of Sun. Therefore, in view of the foregoing arguments applicants respectfully request the Examiner withdraw the Obviousness-Type Double Patenting Rejection as it is improper.

CLAIM OBJECTIONS

Claims 1-7 and 12 were objected to as containing non-elected subject matter. (June 6, 2006 Office Action, Page 18). Applicants have amended Claims 1, 2 and 5 to delete unelected subject matter.

Claim 1 was objected to for reciting the term "including all prodrug esters". Applicants have amended the preamble of Claim 1 to read

"A compound or a prodrug ester or a pharmaceutically acceptable salt or a stereoisomer thereof according to formula I".

Claim 2 was objected to for lacking an "and" between the third and fourth chemical structures. Applicants have amended Claim 2 to insert the term "and" in between the third and fourth chemical structures.

Best Available Copy

CONCLUSION

A fee of \$120.00 pursuant to 37 C.F.R. §1.17(a)(1) for a one (1) month extension of time pursuant to 37 C.F.R. §1.136(a)(1) is believed due for the filing of this Amendment. Please charge the fee for the extension of time to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. If any additional fee should be found to be due please charge said fee to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. In view of the foregoing, applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,



Sammy G. Duncan, Jr., Ph.D.
Attorney for Applicant
Reg. No. 46,675

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
Phone: 609-252-627

Date: October 6, 2006